

REMARKS

Claims 1 to 14 were presented by Applicants and were subject to a restriction requirement. Applicants elected Group I, claims 1-6 with traverse, and the Examiner made the restriction final. Accordingly, claims 7-14 are withdrawn without prejudice. Claim 1 is amended. Claim 3 is canceled. Claims 15-19 are added. No new matter is being added.

The Examiner rejected claims 1-6 under 35 U.S.C. § 101 as directed to non-statutory subject matter because the recitation of a "computer-implemented method" appeared in the claim preamble but not in the body of the claim. Although Applicants disagree with this interpretation, claim 1 is nevertheless amended to make clear that the method is performed electronically and using a computer system. The Examiner is therefore asked to withdraw the rejection.

The Examiner also rejected claims 1-6 under 35 U.S.C. § 102(a) as being anticipated by Miller et al (Miller). Claim 1 as amended recites:

A computer-implemented method for preparing tax returns comprising:

- obtaining, by a computer system, identification data identifying a taxpayer's employer;
- determining, by the computer system via communication over a communications network with a tax data provider associated with the taxpayer's employer, using the identification data and providing taxpayer authentication data to the tax data provider, that tax data about the taxpayer is available from the tax data provider;
- electronically retrieving, from the tax data provider, the tax data about the taxpayer; and
- electronically preparing a tax return for the taxpayer using the retrieved tax data.

The claimed invention enables the automated preparation of tax returns by using identification data about a taxpayer's employer in combination with taxpayer authentication data to determine that a tax data provider has tax information about the taxpayer, and then retrieving the data and using it to prepare a tax return for the taxpayer.

While Miller describes generally a method for automatically preparing tax returns, Miller does not anticipate the claimed invention. For example, Miller does not disclose providing taxpayer authentication data to a tax data provider in order to determine whether the tax data provider has tax data about the taxpayer. As described in Applicants' specification, requiring that taxpayer authentication data be provided helps to ensure privacy and security for the taxpayer's data. For example, in one described embodiment not only the taxpayer's social security number, but the Box 1 Amount found on the taxpayer's W2 must be provided as authentication data to the tax data provider. Since the Box 1 Amount is not generally known to those other than the taxpayer and his authorized representatives, the security of the taxpayer's tax data is ensured. Miller does not teach, suggest or disclose "determining, by the computer system via communication over a communications network with a tax data provider associated with the taxpayer's employer, using the identification data and providing taxpayer authentication data to the tax data provider, that tax data about the taxpayer is available from the tax data provider," as claimed, and claim 1 is therefore patentable over Miller.

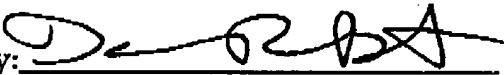
Dependent claims 2 and 4-6 are also patentable over Miller, both because they depend from patentable claim 1, and because they recite their own patentable features. For example, Miller does not disclose the use of an EIN to identify a taxpayer's employer (claim 2); querying a plurality of tax data providers to determine which are associated with the taxpayer's employer (claim

4); or determining whether the taxpayer's employer is one of an identified plurality of employers that provide tax data electronically (claim 5).

In view of the above Remarks, the Examiner is asked to withdraw the rejection and issue a Notice of Allowance. If any matters remain outstanding prior to allowance of the claims, the Examiner is invited to contact the undersigned attorney at (415) 875-2358 or via e-mail at dbrownstone@fenwick.com. Applicants acknowledge that a copy of any electronic mail communications will be made of record in the application file per MPEP § 502.03.

Respectfully submitted,
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